

### **REMARKS**

It is noted that, notwithstanding any claim amendments made herein, Applicant's intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 1-33 are all of the claims pending in the present Application. Claim 1 stands rejected under 35 USC §112, second paragraph, as being indefinite. Claims 1, 2, 5, 6, 10-13, 15, 22, 23, and 29-31 stand rejected under 35 USC §102(e) as anticipated by US Patent 6,335,746 to Enokida et al. Claims 3, 4, 27, and 28 stand rejected as unpatentable over Enokida. Claims 7-9, 14, 16, 25, 26, 32, and 33 stand rejected as unpatentable over Enokida, further in view of US Patent 6,301,586 to Yang et al. Claims 17, 18-21, and 24 stand rejected as unpatentable over Enokida, further in view of Downs.

These rejections are respectfully traversed in view of the following discussion.

#### **I. THE CLAIMED INVENTION**

As described and claimed (e.g., by claim 1), the present invention is directed to a method of processing search results obtained in response to a user query. Document pointers returned by a search engine are provided to identify a source from which documents are available. Each of the document pointers include a Uniform Resource Locator (URL).

At least two visual abstracts are generated for at least one of the documents, each visual abstracts being a thumbnail image of a different size. A stream of data is formatted such that when said data is displayed on a display screen regarding the at least one of the documents, a smaller one of the visual abstracts appears adjacent to a corresponding search result.

An advantage of the present invention over the prior art is that a user can more easily determine relevance of the source document by seeing a thumbnail image of the document and does not need to retrieve the document itself unless it seems sufficiently relevant, thereby saving time and network bandwidth.

S/N: 09/442,150  
Docket: ALM9990095

## II. THE REJECTION BASED ON 35 USC §112, SECOND PARAGRAPH

The Examiner rejects claim 1 as being indefinite. However, Applicants submit that the Examiner is confused as to the purpose of a rejection based on indefiniteness and that the present rejection is improper.

As best understood, the Examiner insists upon rejecting independent claim 1 until all design details of a specific embodiment have been incorporated into the independent claim. Applicants submit that such is not the purpose of indefiniteness and that it defeats the purpose of the broad claims.

Applicants submit that independent claim 1 very clearly defines the metes and bounds, as would be understood by one of ordinary skill in the art and that no additional clarification is needed.

With the above clarification, Applicants respectfully request that the Examiner reconsider and withdraw the rejection for indefiniteness.

## III. THE PRIOR ART REJECTIONS

The Examiner alleges that Enokida anticipates claims 1, 2, 5, 6, 10-13, 15, 22, 23, 29, 30, and 31, renders obvious the invention as defined by claims 3, 4, 27, and 28. The Examiner also alleges that Enokida, when combined with Yang, renders obvious claims 7-9, 14, 16, 25, 26, 32, and 33, and, when combined with Downs, renders obvious claims 17, 18-21, and 24.

Applicants disagree.

First, relative to claim 1, Enokida addresses a method that is confined to a simple file system. There is no suggestion in Enokida to extend any concepts therein to searches on the Internet.

Hence, turning to the clear language of claims 1 and , in Enokida there is no suggestion of: "... providing document pointers returned by a search engine to identify a source from which documents are available, each said document pointer including a Uniform Resource Locator (URL)...."

S/N: 09/442,150  
Docket: ALM9990095

For this reason alone, claims 1-21 are fully patentable over Enokida.

Moreover, relative to claims 22, 29, and 30, the Examiner relies upon the description at lines 23-26 of column 9: *"In other words, the file display processing described in FIG. 7 is executed and the size-adjusted thumbnail images are displayed in the manner shown in window 2 in FIG. 5."*

However, nowhere does this description include any reference to written summary, and Figure 5 clearly fails to show a written summary.

Hence, turning to the clear language of the claims, there is no teaching or suggestion in Enokida of: "... providing abstracts of documents on a screen display that correspond to said search request, said abstracts including a written summary and a first visual abstract of each of said documents ...", as required by independent claims 22, 29, and 30.

For this reason alone, claims 22-33 are fully patentable over Enokida.

Further, for purpose of Appeal, the following errors in the rejection of record are identified.

Relative to the rejections under 35 USC §103(a), the rejection currently of record uses an incorrect legal standard for attempting to combine references. The current rejection uses the standard: *"... a person having ordinary skill in the art would have readily recognized the desirability and advantages of ...."* This statement is merely a conclusory statement and it is nothing except a clear statement of impermissible hindsight.

It is also pointed out that the Examiner's statements of justification are merely statements of the benefit of the missing element. Using this circular reasoning, everything becomes obvious because it would always be obvious to modify a baseline reference to incorporate a missing element in order to incorporate the missing element.

As pointed out in MPEP §2141.02: *"In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious."* [emphasis in MPEP itself]

As MPEP §2141.02 continues: *"[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is*

S/N: 09/442,150

Docket: ALM9990095

*identified.*" In the present invention, the Applicants have recognized various problems with Internet search reports in which only a brief summary is provided, particularly when the search report is lengthy. They have also realized that they would be able to quickly scan through thumbnail images of the documents, especially if the title(s)/subtitle(s) are enhanced for visibility in the thumbnail image. They have also realized that thumbnail images can be transmitted much faster than the entire document.

None of the prior art currently of record recognizes these problems with Internet search reports, let alone provide the solution offered by the present invention.

Along these lines, MPEP §2143.01 provides the evaluation guidelines: "*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*" [emphasis in MPEP itself] This MPEP section also states: "*A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.*"

Applicants submit that none of the urged combinations are proper in view of these MPEP guidelines.

Moreover, since the combination of Downs with Enokida would destroy the ability of Enokida to display the thumbnail images themselves, this combination would be improper under MPEP §2143.01: "*The proposed modification cannot render the prior art unsatisfactory for its intended purpose.*"

Further, the other prior art of record has been reviewed, but it too, even in combination with Enokida, Yang, or Downs, fails to teach, suggest, or render obvious the claimed invention.

S/N: 09/442,150  
Docket: ALM9990095

#### IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-33, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

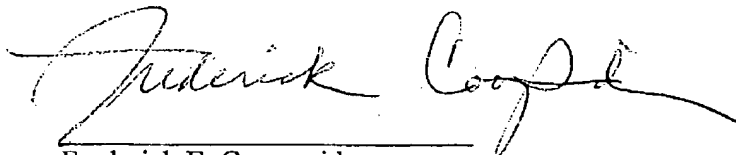
Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 09-0441.

Respectfully Submitted,

Date:

1/27/04

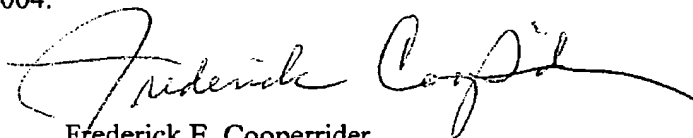


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#### CERTIFICATION OF TRANSMISSION

I certify that I transmitted via facsimile to (703) 872-9306 this Amendment under 37 CFR §1.111 to Examiner K. Parton on January 27, 2004.



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S/N: 09/442,150  
Docket: ALM9990095